REMARKS

Claims 1, 3 and 7 through 23 are currently pending in the application.

This amendment is in response to the Office Action of December 22, 2004

Claim Objections

Claim 3 is objected to due to informalities in the claim language. The appropriate correction has been made.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on Smith (U.S. Patent No. 5,860,362)

Claims 10 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Smith (U.S. Patent 5,860,362). The Applicants respectfully traverse this rejection.

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding independent claim 10, in the Office Action it is not alleged that Smith teaches or suggests the element of the claimed invention calling for "providing at least one user profile database for storing demographic information about users of a personalized media service, said stored demographic information about a user in said user profile database comprising information selected from the group consisting of gender, age, hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences." Applicants assert that Smith does not identically describe such an element of the claimed invention and therefore independent claim 10 is not anticipated under 35 U.S.C. § 102 by Smith. Applicants further assert that Smith makes no mention whatsoever of such an element of the invention of independent claim 10. Therefore, claim 10 is allowable.

Without commenting on the applicability of Leeke et al. as failing to teach or suggest such a claim limitation of independent claim 10, claim 10 would not be obvious under 35 U.S.C. § 103 based on any combination of Smith in view of Leeke et al. for at least the same reasons that claim 1 is allowable over Smith in view of Leeke et al. under 35 U.S.C. § 103.

Claim 12 is allowable as depending from allowable independent claim 10.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Smith (U.S. Patent 5,860,362) in view of Leeke et al. (U.S. Patent 6,587,127)

Claims 1, 3, 9, 11, 13 through 15, and 17 through 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent 5,860,362) in view of Leeke et al. (U.S. Patent 6,587,127). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

Regarding independent claim 1, Applicants assert that any combination of Smith and Leeke et al. does not teach or suggest all of the limitations of the claim to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed invention. In the Office Action, it is noted that Smith does not teach "at least one database of available media selections and corresponding media selection retrieval information for providing media in said data format to said central processing unit." Applicants assert that Leeke et al. does not cure that deficiency in any manner. At a minimum, Leeke et al. does not teach or suggest the claim limitation calling for the "media selections" element. Leeke et al. only teaches providing audio content to a user. See *e.g.*, Column 4, ll. 8-12. Audio content is not an embodiment of the "media selections" of claim 1. Therefore, even if Smith and Leeke et al. are combined, the combination of the references do not teach or suggest the claim limitation calling for "at least one database of available media selections and corresponding media selection retrieval information for providing media in said data format to said central processing unit." Second, there is no suggestion in either Smith or Leeke et al. to combine the references or to modify the audio selection of Leeke et al. into the claim limitation of a "media selection" element of claim 1. Therefore, the rejection is based solely upon

impermissibly relying on hindsight to combine the references based solely upon Applicants' disclosure, not the disclosure in the cited prior art.

Additionally, Nozue et al. and Miyasaka et al. do not cure either deficiency. Therefore, no a *prima facie* case of obviousness under 35 U.S.C. § 103 has been established regarding the claimed invention.

Claims 3, 9, 11, and 13 are allowable as depending from an allowable independent base claim.

Claim 14 was rejected in the Office Action under the same rationale as claim 1 and is allowable over any combination of the cited prior art under 35 U.S.C. § 103 for at least the same reasons as claim 1.

Claims 15 and 17 through 19 are allowable as depending from an allowable base claim.

Obviousness Rejection Based on Smith (U.S. Patent 5,860,362) in view of Leeke et al. (U.S. Patent 6,587,127) in further view of Nozue et al. (U.S. Patent 5,845,262)

Claims 7, 8 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent 5,860,362) in view of Leeke et al. (U.S. Patent 6,587,127) in further view of Nozue et al. (U.S. Patent 5,845,262). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 7, 8, and 16 are allowable as depending from allowable base claims.

Obviousness Rejection Based on Smith (U.S. Patent 5,860,362) in view of Leeke (U.S. Patent 6,587,127) in further view of Miyasaka et al. (U.S. Patent 6,766,362)

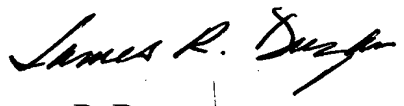
Claims 20 through 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent 5,860,362) in view of Leeke et al. (U.S. Patent 6,587,127) in further view of Miyasaka et al. (U.S. Patent 6,766,362). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 20 through 23 are allowable as depending from an allowable base claim.

In summary, Applicants submit that claims 1, 3, and 7 through 23 are clearly allowable over the cited prior art.

Applicants request the allowance of claims 1, 3, and 7 through 23 and the case passed for issue.

Respectfully submitted,



James R. Duzan
Registration No. 28,393
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

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